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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/071,890      | 02/07/2002  | John V. Frangioni    | BIDM-P01-004        | 8688             |

28120 7590 02/11/2003

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| EXAMINER |
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REYES, HECTOR M

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1625

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/071,890

Applicant(s)

FRANGIONI, JOHN V.

Examiner

Hector M Reyes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 to 66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 to 66 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

**Election/Restrictions**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 6 through 10, 21 through 65, drawn to a series of compounds having the formula described as I, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass.
- II. Claims 2, 6 through 10, 21 through 65, drawn to a series of compounds having the formula described as Ib, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass.
- III. Claims 3, 6 through 10, 21 through 65, drawn to a series of compounds having the formula described as Id, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass.
- IV. Claims 4, 6 through 10, 21 through 65, drawn to a series of compounds having the formula described as Ie, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass.
- V. Claims 5, 6 through 10, 21 through 65, drawn to a series of compounds having the formula described as If, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass.

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- ✓ VI. Claims 17, 21 through 65, drawn to a series of compounds having the formula described as II, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass.
- VII. Claims 18, 21 through 65, drawn to a series of compounds having the formula described as III, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass.
- VIII. Claims 19, 21 through 65, drawn to a series of compounds having the formula described as IV, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass.
- IX. Claims 20, 21 through 65, drawn to a series of compounds having the formula described as V, pharmaceutical compositions comprising the same and a diagnosis kit comprising such derivatives, classified in multiple classes and subclass
- X. Claim 66, drawn to a method of treating a patient suffering form a disease condition as described in such claim, classified in class 564, subclass 1+.

The inventions above outlined are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP §

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808.01). In the instant case the inventions are different because each Groups 1 to XI are drawn to:

- A particular set of compounds having a particular structure which are different from each other and therefore having different classes and subclasses
- Particular pharmaceutical compositions comprising each set of compounds of the particular group
- A diagnosis kit comprising each particular set of compounds
- A given pharmaceutical composition comprising a given set of compounds does not require compounds embraced in any of the other groups.
- A given diagnosis kit comprising a particular set of compounds does not require compounds embraced by any of the other groups.

Invention X is different from any of the inventions I through IX because the claimed method of treatment does not require any of the claimed compounds embraced in such groups.

Moreover, all groups are different because a given reference anticipating or suggesting any of the said inventions under the meaning of 35 USC 102 or 35 USC 103 would not necessarily anticipate or suggests any of the other inventions described above under 35 USC 102 or 35 USC 103.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and the search required for a given Group is not required for the others, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

A) Groups I through VI:

- Derivatives having variable X as oxygen
- Derivatives wherein X is Sulfur
- Derivatives having Y moiety containing phosphorus
- Derivatives having Y moiety containing boron
- Derivatives having Y moiety containing vanadium
- Derivatives having Y moiety containing astatine

B) Groups VII through VIII:

- A variety of different organic compounds embraced by each one of the claimed genus.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all compounds claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

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is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes whose telephone number is 703-605-1153. The examiner can normally be reached on M-F (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Rotman can be reached on (703) 308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Hector M. Reyes, PhD JD  
February 5, 2003



**ALAN L. ROTMAN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**